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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/602,223

Applicant(s)

BLANK, ERIC

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Preliminary Amendment

1. Receipt is acknowledged of the preliminary amendment filed 14 June 2001. Claims 1-80
5 remain for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

10 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18, 35, 66, and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15 Regarding claims 18, 35, 66, and 74, the phrase "adapted to" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 21063.II-B.

Appropriate clarification and correction is required.

20 *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

25 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18, 21-35, 38-54, and 57-80 are rejected under 35 U.S.C. 103(a) as being
5 unpatentable over Warther et al. (US 6,039,356) in view of Leighton (US 6,036,099).

Re claims 1, 5, 11-15, 21, 26-31, 53, 57-59, 62, 63, 68-70, 75-80, Warther teaches a rectangular transaction card (col. 1, lines 23+) with varying embodiments. As shown in figure 12, the card is composed of the main card 71a and auxiliary member 72c, which is connected to the main card on longer edge. Both main and auxiliary card contains machine readable codes
10 21a and 22c (barcodes), and the main card can be applied with magnetic strip (col. 7, lines 40+).

Warther fails to specifically teach or fairly suggest that the transaction card meets ANSI/ISO standard.

Leighton teaches of producing a transaction card such as ATM cards (col. 1, lines 24+), wherein the surface roughness is within ANSI and ISO standard (col. 3, lines 27-33).

15 In view of Leighton's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ such well-known industry standards to the teachings of Warther in order to gain acceptance and increase marketability of the product. Furthermore, a product manufactured according to the industry standard improves interchangeability and can be readily used as a component part of a bigger system. Accordingly,
20 one of ordinary skill in the art would adopt such standards in order to efficiently market their products and improve sales.

Claims 2-4, 38-40, 45, 48, and 65, as shown in figure 12, machine readable code 21a is near a side opposite the auxiliary member 72c, and a scoring line 403. The auxiliary member contains an opening 72d (col. 10, lines 37+), and the card can be used as a key-tag.

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Re claims 6 and 64, in another embodiment shown in figure 2, the main card and auxiliary card is approximately the same size.

Re claims 7,10, and 67, the auxiliary member contains an opening 72d (col. 10, lines 37+), and the card can be used as a key-tag.

5 Re claims 8 46, and 66, Warther further teaches a signature strip (col. 9, lines 59+).

Although

Re claims 9, 47, and 53, the card can be a store credit card, transaction card, or a membership card (col. 1, lines 23+). The card can obviously be purchased and given as a gift.

10 Re claims 16-18, 22, 32-35, 51, 52, 60, 61, and 72-74, Warther further discloses that auxiliary member can be a adhesive label (col. 1, lines 23+; col. 2, line 50 – col. 3, line 4), which contains corresponding code. The adhesive label can be removed and attached to another surface.

Re claims 23-25, 41-44, 54, and 64, as shown in figures 8 and 2, auxiliary card can be joined at the long or short edge of the main card, and the size can be smaller or equal.

15 Re claims 49, 50, and 71, the card contains magnetic strip (col. 7, lines 40+) or the indicia only detectable by an optical reader (col. 6, lines 60+).

4. Claims 19 20, 36, 37, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warther et al. (US 6,039,356) by Leighton (US 6,036,099) as applied to claim 20 1 above, and further in view of Klure (US 6,328,341). The teachings of Warther as modified by Leighton have been discussed above.

Warther/Leighton fails to specifically teach or fairly suggest that the label obscures a PIN number for a prepaid telephone account.

Klure teaches a prepaid telephone card 10 (see abstract; col. 1, lines 14+), whose pin number 14 is hidden until a customer purchases and opens the package.

In view of Klure's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate a notoriously old and well-known PIN number to the teachings of Warther in order to securely protect the value of the prepaid card, and protect the customers. PIN number activated cards and accounts are very well known in the art, and many cards/account are initially in deactivated state. Once a customer calls the service center or enter a correct PIN number, then the account is activated. Accordingly, such modification would have been an obvious extension as taught by Klure to protect both consumer and service provider from fraudulent use. Although Klure does not specifically teach obscuring PIN with a label, PIN is still protected within foldable jacket, which can be achieved by placing the label over the PIN in case of Warther.

15

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Thompson (US 5501491); Kimura (US 5949058); Kenneth et al. (US 5594233); Hansen et al. (US 6315206); Kulbert (US 6199757) disclose transaction card and related methods.

20 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

25 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
April 12, 2002



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